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REMARKS

Claims 1-5, 17 and 18 are currently pending in the subject application and are presently under consideration. A clean version of all pending claims is found at pages 2-3. Claims 1 and 17 have been amended herein. A marked-up version of claim amendments made herein is found on page 9 of this Reply.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-3 and 17 Under 35 U.S.C. §102(b)

Claims 1-3 and 17 are rejected under 35 U.S.C. §102(b) as being anticipated by Bressers (US 4,730,295). Applicant's representative requests that this rejection be withdrawn for the following reasons. Bressers does not teach each and every element of the claims.

"A claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987) Emphasis added. "The identical invention must be shown in as complete detail as is contained in the...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The apparatus of the present invention provides for a cost effective improvement over such conventional devices and manufacturing methodologies by mounting the prism directly onto the aperture of the image sensor component and thereby facilitating reduction in the size of the image sensor assembly. Furthermore, the *prism being mounted to the aperture* provides for a repeatable angular reflection of light. (Page 10, lines 14-23).

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Bressers teaches an apparatus for reading and/or recording a trackwise arranged optical structure in a record carrier that includes a tracking-error detection system with a beam-splitting element and four detectors. A source-emitted beam is passed through a prism and series of lenses to the record carrier structure. A reflected read beam is received back from the record carrier through the lenses and the prism, and directed by the prism to a detector system. The prism is a beam-separating prism that provides separation of the reflected time-modulated read beam from the source-emitted beam. The prism includes a wedge, so that while distanced from the detector system, the wedge splits the beam into two sub-beams and focuses each sub-beam onto respective detector pairs of the detector system.

Claim 1, as amended, recites a scan engine for use in a data collection device that comprises a housing with an opening for receiving light from a scanned dataform, an image sensor with an aperture, the image sensor being located within the housing and operative to sense light entering the aperture, and a prism located within the housing and mounted on the aperture, the prism adapted to receive light from the opening along a first path and to provide at least a portion of the received light to the aperture along a second path.

Claim 17, as amended, recites a method for producing a data collection device scan engine, the method comprising providing a housing with an opening for receiving light from a scanned dataform, mounting an image sensor within the housing, the image sensor having an aperture and being operative to sense light entering the aperture, and mounting a prism on the aperture within the housing, the prism for receiving light from the opening along a first path and providing at least a portion of the received light to the aperture along a second path.

Bressers does not teach or suggest that a prism is mounted on the aperture, and thus does not anticipate the present invention. Moreover, it would not have been obvious to one skilled in the art to incorporate the teachings of Bressers into the present invention, since Bressers teaches away from mounting the prism onto the aperture, by including the wedge in order to focus the sub-beams onto the detector pairs. Therefore, independent

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claims 1 and 17 and the respective claims 2-5 and 18 that depend therefrom should be allowed.

**II. Rejection of Claims 1-5, 17 and 18 Under 35 U.S.C. §102(b)**

Claims 1-5, 17 and 18 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ogura *et al.* (US 5,825,560).

Claims 1-5, 17 and 18 should be allowed for at least the following reasons. With respect to amended independent claims 1 and 17, Ogura *et al.* does not teach or suggest that the prism is mounted on the aperture.

Ogura *et al.* teaches an optical apparatus that includes a photographing optical system and mechanical components mounted on a board. The apparatus includes a number of optical members, some of which are movable to provide a focusing function. The board includes a plurality of openings. Positioned on the under side of the board in one opening is an image sensing element. Positioned on the top surface of the board of the opening is an optical member G4 that guides light to the sensing element. (Col. 9, lines 28-30). In one embodiment thereof, the opening of the board is covered with a glass member 50 that is disposed between the optical member G4 and the board to protect the underlying sensing element. (Col. 9, lines 50-67). In another embodiment, the board is modified so that the optical member G4 is positioned partly into the opening to serve as protection for the underlying sensing element. (Col. 10, lines 1-6).

However, Ogura *et al.* does not disclose that the optical member G4 is mounted directly to the aperture of the sensing element. Thus Ogura *et al.* does not anticipate the present invention as recited in both claims 1 and 17. For the same reasons noted above in Section I, this rejection should be withdrawn, and claims 1-5, 17 and 18 allowed.

**III. Rejection of Claims 1-5, 17 and 18 Under 35 U.S.C. §102(b)**

Claims 1-5, 17 and 18 stand rejected under 35 U.S.C. §102(b) as being anticipated by Shepard (US 3,341,711). The rejection of claims 1-5, 17 and 18 should be withdrawn, since Shepard does teach each and every element of the claimed invention.

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Shepard teaches a photoelectrically controlled luminaire with a prismatic apparatus for directing light to a photo-control unit. The prismatic device is rotatably positioned within a cavity formed by a mounting unit. The device includes a cylindrical light control tube that fits into a similarly structured mounting hole. A light-sensitive cell is positioned below an end of the tube to receive light passing through the device. The prismatic device is secured in the mounting hole by a screw, which screw can be loosened to permit rotation of the device to reorient the angle of light reception. (Col. 3, lines 39-41).

Shepard does not teach or suggest that the prismatic device is mounted to the aperture, since the device is designed to be rotated. Thus Shepard does not anticipate the claims as amended. Moreover, this teaches away from the claimed invention. Consequently, it would not have been obvious to utilize the teachings of Shepard in the instant invention. For the reasons provided herein, and in Sections I and II above, applicant's representative requests that claims 1-5, 17 and 18 be allowed.

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**IV. Conclusion**

The present application is believed to be condition for allowance in view of the above amendments and comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

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**MARKED UP VERSION OF AMENDED CLAIMS**

1. (Amended) A scan engine for use in a data collection device, comprising:  
a housing with an opening for receiving light from a scanned dataform;  
an image sensor with an aperture, the image sensor being located within the housing and operative to sense light entering the aperture; and  
a prism located within the housing and mounted on the aperture, [and] the prism adapted to receive light from the opening along a first path and to provide at least a portion of the received light to the aperture along a second path.

17. (Amended) A method for producing a data collection device scan engine, comprising:  
providing a housing with an opening for receiving light from a scanned dataform;  
mounting an image sensor within the housing, the image sensor having an aperture and being operative to sense light entering the aperture; and  
mounting a prism on the aperture within the housing, the prism for receiving light from the opening along a first path and providing at least a portion of the received light to the aperture along a second path.